Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLIVER NICKEL

Appeal No. 2004-2029
Application No. 09/431,849

HEARD: December 16, 2004

Before KIMLIN, KRATZ and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2-9 and 12. Claim 11, which is the only other claim pending in this application, currently stands withdrawn from consideration by the examiner as drawn to a non-elected invention.

BACKGROUND

Appellant's invention relates to a self-adhesive masking strip. An understanding of the invention can be derived from a reading of exemplary claim 12, which is reproduced below.

> 12. A self-adhesive masking strip, comprised of
> a) a heat-resistant adhesive tape comprising a paper support one side of which is coated with a contact adhesive;
> b) a masking paper adhered to and only partially covering said one side of said adhesive tape and having a width which extends from the locus of its adhesion to said one side of said adhesive tape to beyond one width boundary of said adhesive tape; and
> c) a masking film adhered to and only partially covering the part of said one side of said adhesive tape left uncovered by said masking paper, and which overlaps and covers said masking paper and has a width which exceeds the width of said masking paper.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Patel et al. (Patel)	5,385,783	Jan. 31, 1995
Sakumoto et al. (Sakumoto)	5,683,806	Nov. 04, 1997
Leeuwenburgh	5,935,669	Aug. 10, 1999

Claims 2-9 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Patel in view of Sakumoto and Leeuwenburgh.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by

appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful review of the respective positions advanced by appellants and the examiner with respect to the rejection that is before us for review, we find ourselves in agreement with appellants' viewpoint in that the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection.

All of the claims on appeal require a masking strip that includes, inter alia: (1) a masking paper that only partially covers an adhesive coated side of a paper support, the masking paper having a width dimension which extends beyond a width boundary of the adhesive tape; and (2) a masking film that overlaps and covers the masking paper in a fashion such that the masking film itself is adhered to a portion of an uncovered part of the adhesive coated side of the paper support left uncovered by the masking paper, wherein the masking film has a width that exceeds the width of the masking paper.

The examiner acknowledges that Patel does not disclose a masking strip that includes a masking film as required by all of the appealed claims. Hence, the examiner additionally relies on Sakumoto and/or Leeuwenburgh. Even if we could agree with the examiner that Sakumoto and/or Leeuwenburgh would have led one of ordinary skill in the art to use such a film on the adhesive side of the masking strip of Patel, the examiner, in the stated rejection in the answer, does not specifically address, much less prove that the additional argued differences[1] between the claimed masking strip and Patel's disclosure set forth in items (b) and (c) of claim 12 would have been obvious modifications of Patel's tape based on the combined teachings of the applied references.

In the sentence bridging pages 5 and 6 of the answer, the examiner generally asserts that "the paper/film on the contact adhesive layer is of little consequence and is given little patentable weight in product claims." However, in a rejection under 35 U.S.C. § 103(a), it is basic that all limitations recited in a claim must be considered and given appropriate effect in judging the patentability of that claim against the prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ

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[1] See page 3 of the brief.

789, 791 (CCPA 1974). This, the examiner has failed to do by that general assertion.

Moreover, the examiner's comment at page 8 of the answer concerning the release coat of Patel and the film of Sakumoto serving to "represent the masking paper and masking film, as per instant claim 12" does not further elucidate where the examiner finds a suggestion to modify the masking tape of Patel in a manner so as to arrive at a masking tape that would include all of the particular features of claim 12. In this regard, we note that the release coat of Patel is located on the opposite side of the impregnated paper base of the tape from the adhesive layer thereof whereas claim 12 requires that the masking paper and masking film covering same are both on the adhesive side of the paper base of the tape and positioned in a specific manner relative to each other and the adhesive coated paper base. Nor has the examiner reasonably explained how one of ordinary skill in the art would have been led to a tape corresponding to the appealed claim 12 requirements by modifying the masking tape of Patel based on the teachings of Sakumoto that concern a protective layer for a laminated adhesive layer of a tape having properties useful for electronic parts.

For the above stated reasons, we cannot sustain the § 103 rejection advanced by the examiner on this appeal.

OTHER ISSUES

Prior to final disposition of this application, the examiner should review the claims of commonly owned U.S. Patent No. 6,723,406 and determine whether or not any of the claims of this application conflict with any of the claims of that patent in a manner such that an obviousness-type double patenting rejection is warranted.

CONCLUSION

The decision of the examiner to reject claims 2-9 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Patel in view of Sakumoto and Leeuwenburgh is reversed.

REVERSED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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) INTERFERENCES
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